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Filed : July 14, 2003

REMARKS

Claims 8 and 10-12 are pending. Applicants also respectfully request reconsideration of the application in view of the following remarks.

Rejections Under 35 U.S.C. §102(b)

AU 9640808A

Claims 8 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by Australian publication AU 9640808A.

The final Office Action states that AU 9640808A discloses a polyester film that can be coated on both sides with an adhesive that contains pyrrolidinium rings. The final Office Action states that the reference's teaching of a white polyester film is only a particular embodiment of the reference, the final Office Action apparently implying that other than this particular embodiment, the polyester film of AU 9640808A is transparent.

Applicants have traversed, pointing to AU 9640808A at page 11, lines 12-14, as teaching that, without exception, the disclosed adhesive polyester film always has a magnetic recording layer and/or a printing ink layer, which are not transparent. Applicants have pointed out that all Examples and Comparative Examples describe non-transparent adhesive polyester films. Applicants have point to the teachings of AU 9640808A that indicate that a white pigment in the polyester film is preferred, and the reference never mentions embodiments in which the polyester film lacks pigment.

The Advisory Action responds to Applicants by stating that the reference teaches "magnetic recording layer and/or a printing ink layer is present on at least A PART OF THE SURFACE (and not on the whole surface as alleged by the applicant as 'without exception'). The Advisory Action further states that:

[N]owhere does the reference AU 9640808A recites [*sic*] that the film is 'non-transparent' as contended by the applicant. Further, applicant should note that the instant claims does not specify the DEGREE OF TRANSPARENCY of the claimed protective film. In other words, the claim fails to teach if the transparency is 100% or 1 % and, in the absence of such a teaching, the portective film of AU 9640808A is found to be transparent and reads on the invention as claimed.

Applicable Law

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"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "An invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that "[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category" but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species.).

AU 9640808A does not Expressly or Inherently Anticipate the Claims

AU 9640808A does not expressly state that the adhesive polyester film described therein is transparent. The PTO appears to agree, pointing to no such express teaching in AU 9640808A. Accordingly, AU 9640808A does not expressly anticipate Claims 8 and 12 which are directed to transparent surface protective films.

Instead, the PTO asserts that the adhesive polyester film of AU 9640808A is inherently transparent: "The polyester film is understood to be inherently transparent as admitted by the applicant [in] the specification" *Final Office Action* at page 3. However, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is

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necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added, citations omitted).

Applicants’ specification does not refer to AU 9640808A, and makes no comment about any component of the transparent surface protective film that is necessarily identical to those used in AU 9640808A. Accordingly, Applicants’ specification makes no admission as to the opaqueness or transparency of any component of the adhesive polyester film of AU 9640808A, and cannot support an assertion that Applicants’ teachings render the adhesive polyester film of AU 9640808A inherently transparent.

Therefore, it is necessary to look at the teachings of AU 9640808A itself to determine whether or not the adhesive polyester film of AU 9640808A is inherently transparent. Page 11, lines 12-14 of AU 9640808A, teaches that the disclosed adhesive polyester film always has a magnetic recording layer and/or a printing ink layer, which is not transparent. The Advisory Action states that the reference teaches “magnetic recording layer and/or a printing ink layer is present on at least A PART OF THE SURFACE.” Thus, the PTO appears to assert that there is a **possibility** that the magnetic recording layer and/or a printing ink layer, which is always present, does not cover the entire surface of the adhesive coating film. Mere possibility is insufficient to establish that the claimed subject matter is inherently anticipated. *Id.*

Furthermore, all of the Examples and Comparative Examples of AU 9640808A describe non-transparent adhesive polyester films. The reference never presents any embodiment in which the adhesive polyester film lacks pigment. The Advisory Actions considers this to be unconvincing because “nowhere does the reference AU 9640808A recites [*sic*] that the film is ‘non-transparent’ ”. Thus, the PTO appears to assert that there is a **possibility** that the adhesive polyester film lacks pigment. Mere possibility is insufficient to establish that the claimed subject matter is inherently anticipated. *Id.*

Moreover, the PTO’s rejection depends on the combination of possibilities discussed in the preceding two paragraphs. That is, the PTO’s assertion of inherency depends on an embodiment in the AU 9640808A in which magnetic recording layer and/or a printing ink layer

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is present on only a part of the surface (a mere possibility), and the adhesive polyester film lacks pigment (a mere possibility). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Nothing in AU 9640808A provides anything beyond a mere possibility that the adhesive polyester film is transparent. Accordingly, nothing in AU 9640808A can be used to establish the inherency of the transparency of the adhesive polyester film of AU 9640808A.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The PTO's assertion that "nowhere does the reference AU 9640808A recites [*sic*] that the film is 'non-transparent' " is insufficient to establish inherency. Absent more than pointing to an absence of a teaching in AU 9640808A, inherency cannot be established.

In conclusion, AU 9640808A does not disclose, expressly or inherently, that the disclosed adhesive polyester film is transparent. As such, AU 9640808A does not disclose all elements of Claims 8 and 12. In view of the above, Applicants submit that Claims 8 and 12 are novel over the film of AU 9640808A, and respectfully request removal of this ground for rejecting Claims 8 and 12.

Malhotra

Claims 8 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by the Malhotra (U.S. Pat. No. 5,534,374).

The final Office Action states that Malhotra discloses a transparent polyester substrate.

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Applicants responded by pointing out that Malhotra does not disclose an antistatic layer comprising polymers having pyrrolidinium rings in their main chains.

The Advisory Action responds by stating that “[t]his is not found to be persuasive because Malhotra clearly teaches that the antistatic pyrrolidinium ring structure in col. 30 and discloses that the radical R can include carbon atom of 20 or 30, which is taken to be the polymer chain.”

Malhotra does not Expressly or Inherently Anticipate the Claims

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Malhotra does not expressly disclose an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. The PTO appears to agree, pointing to no such express teaching in Malhotra. Accordingly, Malhotra does not expressly anticipate Claims 8 and 12 which recite an antistatic layer comprising polymers having pyrrolidinium rings in their main chains.

Instead, the PTO appears to assert that Malhotra inherently discloses pyrrolidinium rings in their main chains: “Malhotra clearly teaches that the antistatic pyrrolidinium ring structure in col. 30 and discloses that the radical R can include carbon atom of 20 or 30, which is taken to be the polymer chain.” *Advisory Action*.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Advisory Action provides no basis in fact for considering that a radical R which “can include carbon atom of 20 or 30” can be “taken to be the polymer chain”. Thus, the PTO bases the rejection on an unsupported assertion that a radical R that can include carbon atom of 20 or 30 can be a polymer chain. It is well established that such assertions must be substantiated by supporting evidence (*See In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). Absent

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supporting evidence, the rejection cannot rely on this assertion, and absent supporting evidence, the rejection cannot rely on the theory of inherency.

Applicants submit that it is not possible to support the assertions of the Advisory Action because Malhotra's teaching of a pyrrolidine containing a radical group of, e.g., 20 or 30 carbons is not a teaching of a pyrrolidine in the main chain of a polymer. A polymer should have a particular repeating composition. Malhotra's pyrrolidine acid salt does not have such a repeating composition; it contains only one pyrrolidine ring per molecule. On the other hand, the main chains of polymers of this application contain number of repeating pyrrolidine rings. Malhotra neither expressly nor inherently discloses a polymer having pyrrolidinium rings in the main chain. A disclosure of a single pyrrolidine containing a radical group of, e.g., 20 or 30 carbons is not equivalent to a polymer having pyrrolidinium rings in the main chain. Accordingly, the disclosure of Malhotra does not teach all elements of Claim 8. As such, because Malhotra does not teach all elements of Claim 8, Malhotra does not anticipate Claim 8 or any claim dependent therefrom.

In view of the above, Applicants submit that Claim 8 is novel over the film of Malhotra, and respectfully request removal of this ground for rejecting Claims 8 and 12.

Rejection Under 35 U.S.C. §103

Claims 10 and 11 are rejected under 35 U.S.C. §103 as being anticipated by AU 9640808A or Malhotra.

The Office Action states that it would have been obvious to optimize the adhesive thickness through routine experimentation.

Applicants have pointed to AU 9640808A, which teaches:

The thickness of the final dried coating film needs to be 0.01 to 1 μm , preferably 0.02 to 0.6 μm . If the thickness [*sic*] is less than 0.01 μm , sufficient antistatic properties cannot be obtained and if the thickness is more than 1 μm , lubricity deteriorates unfavorably. AU 9640808A at page 10, lines 22-27 (emphasis added).

Based on this, Applicants have submitted that AU 9640808A teaches that modification of the adhesive layer of AU 9640808A to the thicknesses recited in Claims 10 and 11 would result in

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unfavorable deterioration of lubricity, and thus, teaches away from the thicknesses of the adhesive layer recited Claims 10 and 11.

Applicants have pointed to Malhotra, which teaches:

When an adhesive layer is employed, it preferably forms a uniform and continuous layer having a thickness of about 0.5 micron or less to ensure satisfactory discharge during the imaging process. *Malhotra* at column 12, lines 59-62.

Based on this, Applicants have submitted that Malhotra teaches that an adhesive layer such as that recited in Claims 10 or 11 would not be desirable because it would not be capable of ensuring satisfactory discharge during the imaging process, and thus, teaches away from the thicknesses of the adhesive layer recited Claims 10 and 11.

The Advisory Action responds by stating that the references teach that the adhesive layer can also be of any thickness. In regard to the teachings away from the recited thicknesses, the Advisory Action states "applicant should note that it does not state that the higher thickness is not possible."

Applicable Law

Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). A *prima facie* case of obviousness can be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Applicant can rebut a presumption of obviousness based on a claimed invention that falls within a prior art range by showing "[t]hat the prior art taught away from the claimed invention." *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004).

Claims 10 and 11 also are non-obvious over AU 9640808A and Malhotra

The final Office Action takes the position that the claimed adhesive layer thicknesses represent a mere obvious optimization of the adhesive layers of the cited references. Thus, the PTO

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takes the position that one of ordinary skill in the art, relying only on the teachings in the references, would have been motivated to modify the references in such a way that all limitations of Claims 10 and 11 would be met.

However, the motivation to modify the references must be found only in the cited references. Under the PTO's assertion that the claimed subject matter would have been a mere obvious optimization of the teachings of the references, the motivation for optimization of the recited thickness must come solely from the cited references. As is clear from the above sections of both AU 9640808A and Malhotra, optimization of the thickness of the adhesive layer based on the teachings of the references would have resulted in thicknesses of 1 micron or less, and 0.5 micron or less, respectively. Thus, optimization of the adhesive layer thickness, based on the teachings of the cited references, would have lead to adhesive layer thicknesses outside of the scope of the claims.

The Advisory Action, as basis for its position that the claimed thicknesses would have been obvious optimizations of the references, states "applicant should note that it does not state that the higher thickness is not possible." An absence of teaching that the claimed thickness "is not possible" cannot supersede explicit teachings by both references on how to optimize the thickness of the adhesive layer. Both references teach optimization of the adhesive layer in such a manner that would have lead to adhesive layer thicknesses outside of the scope of the claims. Only Applicants' specification teaches an optimization that would to the claimed adhesive layer thicknesses, and Applicants' specification cannot be relied on for motivation in an obviousness rejection. There is no evidence that one of ordinary skill in the art, using only the teachings in the cited references, would have considered it obvious to optimize the adhesive layer thickness to fall within the scope of the claims. However, there is evidence that one of ordinary skill in the art, using the teachings in the cited references, would have optimized the adhesive layer such that the thicknesses was 1 micron or less, and 0.5 micron or less. Thus, the evidence of record supports the non-obviousness of the claims.

Claims 10 and 11 also are non-obvious over the cited references for at least the reasons presented in regard to Claims 8 and 12 above. Specifically, nothing in AU 9640808A would have motivated one of ordinary skill in the art to develop a transparent surface protective film in accordance with Claim 8 because AU 9640808A teaches the desirability of a polyester to contain a

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white pigment, and the necessity of the polyester film to contain a non-transparent ink layer and/or a non-transparent magnetic recording layer. Accordingly, it would not have been obvious to modify the reference to arrive at the transparent surface protective film of Claim 8, from which Claims 10 and 11 depend.

Furthermore, Claims 10 and 11 also are non-obvious over Malhotra for at least the reasons presented in regard to Claims 8. Specifically, nothing in Malhotra would have motivated one of ordinary skill in the art to art to develop a transparent surface protective film in accordance with Claim 8 because Malhotra does not teach or suggest the desirability of an antistatic layer comprising polymers having pyrrolidinium rings in their main chains.

In conclusion, Claims 10 and 11 are non-obvious over the cited references.

CONCLUSION

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: February 22, 2007

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